UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Donald J. Stavely, K. Douglas Gennetten,
David K. Campbell, and Paul M. Hubel

Appeal No. 2006-3221
Application No. 09/955,457
Technology Center 2600

ON BRIEF

Before KRASS, RUGGIERO, and DIXON, *Administrative Patent Judges.*

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. §134 from the Examiner's final rejection of claims 1-24, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

Appellants' invention relates to a system and method for simulating fill flash in photography. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

> 1. A method of simulating fill flash in a camera system comprising the steps of:
>
> a) determining distances from the camera to objects in a scene; and
>
> b) taking a photograph of the scene without using a flash; and
>
> c) selectively adjusting the brightness of regions of the photograph based on the distance information.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Nishimura et al. (Nishimura)	5,617,141	Apr. 1, 1997
Miyadera	5,550,587	Aug. 27, 1996
Parulski et al. (Parulski)	5,563,658	Oct. 8, 1996
Kikuchi	6,757,020	June 29, 2004

REJECTIONS

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejections, we make reference to the Examiner's answer (mailed June 12, 2006) for the reasoning in support of the rejection, and to Appellants' brief (filed April 18, 2006) and reply brief (filed July 20, 2006) for the arguments thereagainst.

Claims 1, 7, and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura. Claims 2-4, 8-11, and 23-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura in view of Parulski. Claims 5-6 and 12-13 stand rejected under 35

U.S.C. 103(a) as being unpatentable over Nishimura in view of Miyadera. Claims 15-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nishimura in view of Kikuchi.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, *e.g.*, Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." Dembiczak, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." In re Hiniker Co., 150 F.3d 1362,1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations as recited in independent claim 1. We find that the claim recites a method of "simulating fill . . . selectively adjusting the brightness of regions of the photograph based on the distance information."

From our review of the Examiner's rejection and responsive arguments, we cannot find that the Examiner has met the initial burden of establishing a prima facie case of obviousness. Appellants argue that:

> Nishimura et al. do not teach this claim element [selectively adjusting]. In support of the rejection, the examiner cites column 5 line 52 through column 7 line 17 of Nishimura et al. While part of the cited passage does describe exposure control, no mention is made of selectively adjusting the brightness of regions of the photograph. The system of Nishimura et al. uses a different "detection characteristic" to set exposure depending on scene "ambience". (Nishimura et al. column 7 lines 14-17.) Exposure is controlled using a "stop" (Nishimura et al. colmnn 2 lines 10-14 and column 3 lines 48-49) or an exposure time (column 4 lines 5-9). As is well known, a controlling exposure using either a stop, or an exposure time, or both affects the exposure of an entire photograph substantially uniformly. Different regions of the photograph are not affected selectively by Nishimura et al.

Appellants respectfully notes that the "regions" depicted in Figure 4 of Nishimura et al. are not regions an entire photograph. Nishimura's Figure 4 is not a map of a scene or photograph, but is an abstract construct for categorizing a particular scene based on measurements of the subject illumination and a background distance. A particular location in the "map" of Nishimura et al. does not correspond to a particular location in a scene, but indicates a characteristic of the entire scene. (Nishimura et al, column 5 lines 18-51, column 2 lines 54-62, and Figure 4) [Br. 4].

We agree with Appellants that Nishimura does not teach or fairly suggest selectively adjusting the brightness of regions of the photograph based on the distance information which was determined from the camera to plural objects in a scene. Therefore, Nishimura would have to teach measuring multiple distances within a single photograph and selectively adjusting plural regions within the single photograph. Here, we finf that the Examiner has not shown where Nishimura teaches all of the limitations in independent claim 1.

The Examiner maintains that:

> the Nishimura reference does selectively adjust the brightness of regions of the photograph. Since the regions are not specifically defined in claims 1, 7 and 14, the examiner is interpreting this limitation to mean that the brightness is selectively adjusted based on distance information, and that the regions include the entire image. Therefore, in the Nishimura reference, the brightness of the "regions" (i.e. the entire image) is adjusted based on the distance information (column 5, lines 33-48) (Answer, pp. 14-15).

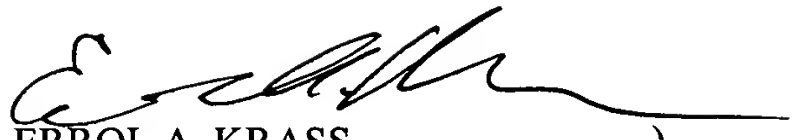
We cannot agree with the Examiner's interpretation since the claim expressly requires more than a single region such as the entire photograph. Therefore, we find the Examiner's interpretation to be unreasonable, and we cannot sustain the rejection of independent claim 1. We find similar limitations in independent claims 7 and 14 which the Examiner has not shown in the express teachings of Nishimura or provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the relevant art at the time of the invention. Therefore, we cannot sustain the rejection of independent claims 7 and 14.

With respect to the dependent claims, the Examiner does not identify how the teachings of Parulski, Miyadera, or Kikuchi remedy the deficiency in Nishimura (and Official Notice). Therefore, we cannot sustain the rejection of the dependent claims 2-6, 8-13, and 15-24.

CONCLUSION

To summarize, we have reversed the rejection of claims 1-24 under 35 U.S.C. § 103.

REVERSED



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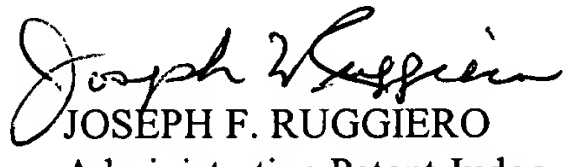
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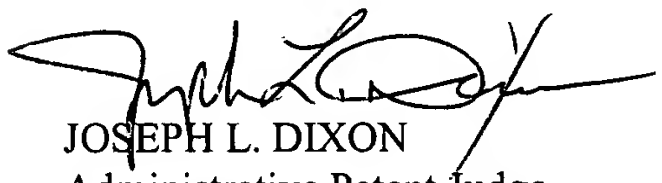
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